

05/30/00
JC840 U.S. PRO

Practitioner's Docket No. 701039-48802 C

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Box Patent Application
Assistant Commissioner for Patents
Washington, D.C. 20231

JC531 U.S. PRO
09/580803
05/30/00

NEW APPLICATION TRANSMITTAL

Transmitted herewith for filing is the patent application of
Inventor(s): Michael KLAGSBRUN, Shay SOKER, Hua-Quan MIAO, Seiji TAKASHIMA.

WARNING: 37 C.F.R. § 1.41(a)(1) points out:

"(a) A patent is applied for in the name or names of the actual inventor or inventors.

(1) The inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribed by § 1.63, except as provided for in § 1.53(d)(4) and § 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the application papers filed pursuant to § 1.53(b), unless a petition under this paragraph accompanied by the fee set forth in § 1.17(i) is filed supplying or changing the name or names of the inventor or inventors."

For (title): ANTAGONISTS OF NEUROPILIN RECEPTOR FUNCTION AND USE THEREOF

CERTIFICATION UNDER 37 C.F.R. 1.10*

(Express Mail label number is **mandatory**.)

(Express Mail certification is optional.)

I hereby certify that this correspondence and the documents referred to as attached therein are being deposited with the United States Postal Service on this date 30 May 2000, in an envelope as "Express Mail Post Office to Addressee," mailing Label Number EK571074376US, addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

Nicholas A. Zachariades

(type or print name of person mailing paper)

Nicholas A. Zachariades

Signature of person mailing paper

WARNING: Certificate of mailing (first class) or facsimile transmission procedures of 37 C.F.R. 1.8 cannot be used to obtain a date of mailing or transmission for this correspondence.

***WARNING:** Each paper or fee filed by "Express Mail" **must** have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. 1.10(b).
"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will **not** be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

SECRET

(check one applicable item below)

- WARNING:** Do not use this transmittal for a completion in the U.S. of an International Application under 35 U.S.C. 371(c)(4), unless the International Application is being filed as a divisional, continuation or continuation-in-part application.

NOTE: *If one of the following 3 items apply, then complete and attach ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF A PRIOR U.S. APPLICATION CLAIMED and a NOTIFICATION IN PARENT APPLICATION OF THE FILING OF THIS CONTINUATION APPLICATION.*

- 2. Benefit of Prior U.S. Application(s) (35 U.S.C. 119(e), 120, or 121)**

NOTE: *A nonprovisional application may claim an invention disclosed in one or more prior filed copending nonprovisional applications or copending international applications designating the United States of America. In order for a nonprovisional application to claim the benefit of a prior filed copending nonprovisional application or copending international application designating the United States of America, each prior application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. Each prior application must also be:*

- (i) *An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or*
- (ii) *Complete as set forth in § 1.51(b); or*
- (iii) *Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16; or*
- (iv) *Entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(l) within the time period set forth in § 1.53(f).*

37 C.F.R. § 1.78(a)(1).

NOTE *If the new application being transmitted is a divisional, continuation or a continuation-in-part of a parent case, or where the parent case is an International Application which designated the U.S., or benefit of a prior provisional application is claimed, then check the following item and complete and attach ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.*

WARNING: *If an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. 120, 121*

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☒ The new application being transmitted claims the benefit of prior U.S. application(s).
Enclosed are ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE
BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

3. Papers Enclosed

A. Required for Filing Date under 37 C.F.R. § 1.53(b) (Regular) or 37 C.F.R. § 1.153 (Design) Application

<u>46</u>	Pages of Specification
<u>2</u>	Pages of Claims
<u>21</u>	Sheets of Drawing

WARNING: *DO NOT* submit original drawings. A high quality copy of the drawings should be supplied when filing a patent application. The drawings that are submitted to the Office must be on strong, white, smooth, and non-shiny paper and meet the standards according to § 1.84. If corrections to the drawings are necessary, they should be made to the original drawing and a high-quality copy of the corrected original drawing then submitted to the Office. Only one copy is required or desired. For comments on proposed then-new 37 C.F.R. 1.84, see Notice of March 9, 1988. (1990 O.G. 57-62).

NOTE: "Identifying indicia, if provided, should include the application number or the title of the invention, inventor's name, docket number (if any), and the name and telephone number of a person to call if the Office is unable to match the drawings to the proper application. This information should be placed on the back of each sheet of drawing a minimum distance of 1.5 cm. (5/8 inch) down from the top of the page. . ." 37 C.F.R. § 1.84(c).

(complete the following, if applicable)

[] The enclosed drawing(s) are photograph(s), and there is also attached a "PETITION TO ACCEPT PHOTOGRAPH(S) AS DRAWING(S)." 37 C.F.R. § 1.84(b).

[]	Formal
[X]	Informal

B. Other Papers Enclosed

	Pages of declaration and power of attorney
<u>1</u>	Pages of Abstract
<u>9</u>	Other (Sequence Listing)

4. **Additional Papers Enclosed**

- ☐ Amendment to claims
- ☐ Cancel in this applications claims _____ before calculating the filing fee. (At least one original independent claim must be retained for filing purposes.)
- ☐ Add the claims shown on the attached amendment. (Claims added have been numbered consecutively following the highest numbered original claims.)
- ☐ Preliminary Amendment
- ☐ Information Disclosure Statement (37 C.F.R. § 1.98)
- ☐ Form PTO-1449 (PTO/SB/08A and 08B)
- ☐ Citations
- ☐ Declaration of Biological Deposit
- ☐ Submission of "Sequence Listing," computer readable copy and/or amendment pertaining thereto for biotechnology invention containing nucleotide and/or amino acid sequence.
- ☐ Authorization of Attorney(s) to Accept and Follow Instructions from Representative
- ☐ Special Comments
- ☐ Other

5. **Declaration or Oath (including power of attorney)**

NOTE: A newly executed declaration is not required in a continuation or divisional application provided the prior nonprovisional application contained a declaration as required, the application being filed is by all or fewer than all the inventors named in the prior application, there is no new matter in the application being filed, and a copy of the executed declaration filed in the prior application (showing the signature or an indication thereon that it was signed) is submitted. The copy must be accompanied by a statement requesting deletion of the names of person(s) who are not inventors of the application being filed. If the declaration in the prior application was filed under § 1.47 then a copy of that declaration must be filed accompanied by a copy of the decision granting § 1.47 status or, if a nonsigning person under § 1.47 has subsequently joined in a prior application, then a copy of the subsequently executed declaration must be filed. See 37 C.F.R. § 1.63(d)(1)-(3).

NOTE: A declaration filed to complete an application must be executed, identify the specification to which it is directed, identify each inventor by full name, including the family name, and at least one given name without abbreviation together with any other given name or initial, and the residence, post office address and country of citizenship of each inventor, and state whether the inventor is a sole or joint inventor. 37 C.F.R. § 1.63(a)(1)-(4).

☐ Enclosed

Executed by

(check all applicable boxes)

- ☐ inventor(s).
- ☐ legal representative of inventor(s). 37 C.F.R. § 1.42 or 1.43.
- ☐ joint inventor or person showing a proprietary interest on behalf of inventor who refused to sign or cannot be reached.

8. **Assignment**

☒ An assignment of the invention to Children's Medical Center Corporation

☐ is attached. A separate ☐ "COVER SHEET FOR ASSIGNMENT (DOCUMENT) ACCOMPANYING NEW PATENT APPLICATION" or ☐ FORM PTO 1595 is also attached.

☒ will follow.

NOTE: "If an assignment is submitted with a new application, send two separate letters—one for the application and one for the assignment" Notice of May 4, 1990 (1114 O.G. 77-78).

WARNING: A newly executed "STATEMENT UNDER 37 C.F.R. § 3.73(b)" must be filed when a continuation-in-part application is filed by an assignee. Notice of April 30, 1993, 1150 O.G. 62-64.

9. **Certified Copy**

Certified copy(ies) of application(s)

Country	Appln. no.	Filed
Country	Appln. no.	Filed
Country	Appln. no.	Filed

from which priority is claimed

☐ is (are) attached.

☐ will follow.

NOTE: The foreign application forming the basis for the claim for priority must be referred to in the oath or declaration. 37 C.F.R. § 1.55(a) and 1.63.

NOTE: This item is for any foreign priority for which the application being filed directly relates. If any parent U.S. application or International Application from which this application claims benefit under 35 U.S.C. 120 is itself entitled to priority from a prior foreign application, then complete item 18 on the ADDED PAGES FOR NEW APPLICATION TRANSMITTAL WHERE BENEFIT OF PRIOR U.S. APPLICATION(S) CLAIMED.

10. **Fee Calculation (37 C.F.R. § 1.16)**

A. ☒ Regular application

CLAIMS AS FILED

Claims	Number Filed	Basic Fee Allowance	Number Extra	Rate	Basic Fee 37 C.F.R. § 1.16(a) \$760.00
Total Claims					

(37 C.F.R. §
1.16(c))

- 20 =

X

\$ 18.00

Independent Claims

(37 C.F.R. §
1.16(b))

- 3 =

x

\$ 78.00

Multiple Dependent

Claim(s), if any

 $+$

\$260.00

(37 C.F.R. §

1.16(d))

[illegible]

11. Small Entity Statement(s)

Filing Fee Calculation \$_____

Filing Fee Calculation \$_____

Filing Fee Calculation \$_____

WARNING: *“Status as a small entity must be specifically established in each application or patent in which the status is available and desired. Status as a small entity in one application or patent does not affect any other application or patent, including applications or patents which are directly or indirectly dependent upon the application or patent in which the status has been established. The refiling of an application under § 1.53 as a continuation, division, or continuation-in-part (including a continued prosecution application under § 1.53(d)), or the filing of a reissue application requires a new determination as to continued entitlement to small entity status for the continuing or reissue application. A nonprovisional application claiming benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) of a prior application, or a reissue application may rely on a statement filed in the prior application or in the patent if the nonprovisional application or the reissue application includes a reference to the statement in the prior application or in the patent or includes a copy of the statement in the prior application or in the patent and status as a small entity is still proper and desired. The payment of the small entity basic statutory filing fee will be treated as such a reference for purposes of this section.” 37 C.F.R. § 1.28(a)(2).*

(complete the following, if applicable)

☐ Status as a small entity was claimed in prior application
_____/_____, filed on _____ from which benefit is being
claimed for this application under:

35 U.S.C. § [] 119(e),
[] 120,
[] 121,
[] 365(c),

00000000000000000000

\$ _____

Total Fees Enclosed

\$

[] Check in the amount of \$_____.

WARNING: *If no fees are to be paid on filing, the following items should not be completed.*

[] The Commissioner is hereby authorized to charge the following additional fees by this paper and during the entire pendency of this application to Account No. _____.

[] 37 C.F.R. § 1.16(a), (f) or (g) (filing fees)

[] 37 C.F.R. § 1.16(b), (c) and (d) (presentation of extra claims)

NOTE: Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims cancelled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 C.F.R. § 1.16(d)), it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.

[] 37 C.F.R. § 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application)

[] 37 C.F.R. § 1.17(a)(1)-(5) (extension fees pursuant to § 1.136(a).

[] 37 C.F.R. § 1.17 (application processing fees)

NOTE: "A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for

0-9

[] 37 C.F.R. § 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 C.F.R. § 1.311(b))

NOTE: 37 C.F.R. § 1.28(b) requires “Notification of any change in status resulting in loss of entitlement to small entity status must be filed in the application . . . prior to paying, or at the time of paying, . . . issue fee.” From the wording of 37 C.F.R. § 1.28(b), (a) notification of change of status must be made even if the fee is paid as “other than a small entity” and (b) no notification is required if the change is to another small entity.

NOTE: "... Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amounts; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account." 37 C.F.R. § 1.26(a).

[] Refund



David S. Resnick
NIXON PEABODY LLP
101 Federal Street
Boston, MA 02110

NOTE: See 37 C.F.R. § 1.78.

WARNING: *If an application claims the benefit of the filing date of an earlier filed application under 35 U.S.C. 120, 121 or 365(c), the 20-year term of that application will be based upon the filing date of the earliest U.S. application that the application makes reference to under 35 U.S.C. 120, 121 or 365(c). (35 U.S.C. 154(a)(2) does not take into account, for the determination of the patent term, any application on which priority is claimed under 35 U.S.C. 119, 365(a) or 365(b).) For a c-i-p application, applicant should review whether any claim in the patent that will issue is supported by an earlier application and, if not, the applicant should consider canceling the reference to the earlier filed application. The term of a patent is not based on a claim-by-claim approach. See Notice of April 14, 1995, 60 Fed. Reg. 20,195, at 20,205.*

(complete the following, if applicable)

[X] Amend the specification by inserting, before the first line, the following sentence:

A. 35 U.S.C. 119(e)

NOTE: "Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of series code and serial number)." 37 C.F.R. § 1.78(a)(4).

[] "This application claims the benefit of U.S. Provisional Application(s) No(s).:

APPLICATION NO(S).:

FILING DATE

_____ / _____

_____ / _____

_____ / _____

B. 35 U.S.C. 120, 121 and 365(c)

NOTE: "Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. . . . Cross-references to other related applications may be made when appropriate." (See § 1.14(a)). 37 C.F.R. § 1.78(a)(2).

[X]“This application is a

[X]continuation

[illegible]

of copending application(s)

[X] International Application PCT/US98/ 26114 filed on 9 December 1998
and which designated the U.S.”

NOTE: (1) Where the application being transmitted adds subject matter to the International Application, then the filing can be as a continuation-in-part or (2) if it is desired to do so for other reasons then the filing can be as a continuation.

NOTE: The deadline for entering the national phase in the U.S. for an international application was clarified in the Notice of April 28, 1987 (1079 O.G. 32 to 46) as follows:

“The Patent and Trademark Office considers the International application to be pending until the 22nd month from the priority date if the United States has been designated and no Demand for International Preliminary Examination has been filed prior to the expiration of the 19th month from the priority date and until the 32nd month from the priority date if a Demand for International Preliminary Examination which elected the United States of America has been filed prior to the expiration of the 19th month from the priority date, provided that a copy of the international application has been communicated to the Patent and Trademark Office within the 20 or 30 month period respectively. If a copy of the international application has not been communicated to the Patent and Trademark Office within the 20 or 30 month period respectively, the international application becomes abandoned as to the United States 20 or 30 months from the priority date respectively. These periods have been placed in the rules as paragraph (h) of § 1.494 and paragraph (i) of § 1.495. A continuing application under 35 U.S.C. 365(c) and 120 may be filed anytime during the pendency of the international application.”

[X] "The nonprovisional application designated above, namely application
PCT / US98/26114, filed 9 December 1998
 claims the benefit of U.S. Provisional Application(s) No(s).:

APPLICATION NO(S).:

FILING DATE

60 / 069,155	9 December 1997
60 / 069,687	12 December 1997
60 / 078,541	19 March 1998

☒ Where more than one reference is made above please combine all references into one sentence.

THE UNIVERSITY OF CHICAGO

Country	Appln. no.	Filed
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[] been filed on _____, in prior application 0 / _____, which was filed on _____.

WARNING: *The certified copy of the priority application that may have been communicated to the PTO by the International Bureau may not be relied on without any need to file a certified copy of the priority application in the continuing application. This is so because the certified copy of the priority application communicated by the International Bureau is placed in a folder and is not assigned a U.S. serial number unless the national stage is entered. Such folders are disposed of if the national stage is not entered. Therefore, such certified copies may not be available if needed later in the prosecution of a continuing application. An alternative would be to physically remove the priority documents from the folders and transfer them to the continuing application. The resources required to request transfer, retrieve the folders, make suitable record notations, transfer the certified copies, enter and make a record of such copies in the Continuing Application are substantial. Accordingly, the priority documents in folders of international applications that have not entered the national stage may not be relied on. Notice of April 28, 1987 (1079 O.G. 32 to 46).*

NOTE: The PTO finds it useful if a copy of the petition filed in the prior application extending the term for response is filed with the papers constituting the filing of the continuation application. Notice of November 5, 1985 (1060 O.G. 27).

(This item **must** be completed and the papers filed in the prior application, if the period set in the prior application has run.)

☐ A copy of the petition filed in prior application is attached.

(complete this item, if previous item not applicable)

☐ **A copy of the conditional petition filed in the prior application is attached.**

(complete applicable item (a), (b) and/or (c) below)

- (type name(s) of inventor(s) to be deleted)

- (type name(s) of inventor(s) to be deleted)

- (Added Pages for Application Transmittal Where Benefit of Prior U.S. Application(s) Claimed—page 4 of 5)

SECRET

NOTE: Where it is possible that the claims on file will give rise to a first action final for this continuation application and for some reason an amendment cannot be filed promptly (e.g., experimental data is being gathered) it may be desirable to file a petition for suspension of prosecution for the time necessary.

[] There is provided herewith a Petition To Suspend Prosecution for the Time Necessary to File An Amendment (New Application Filed Concurrently)

☐ Applicant has established small entity status by the filing of a statement in parent application
/_____ on _____.

WARNING: See 37 CFR § 1.28(a).

[] A notification of the filing of this
(check one of the following)

[] continuation-in-part

is being filed in the parent application, from which this application claims priority under 35 U.S.C. § 120.

PATENT

jc531 U.S. PTO
09/580803
05/30/00

In re application of: Michael KLAGSBRUN, Shay SOKER, Hua-Quan MIAO, and Seiji TAKASHIMA
Application No.:
Filed: Herewith
For: ANTAGONISTS OF NEUROPILIN RECEPTOR FUNCTION AND USE THEREOF

Assistant Commissioner for Patents
Washington, D.C. 20231

EXPRESS MAIL CERTIFICATE

"Express Mail" label number EK571074376US
Date of Deposit 05/30/2000

I hereby state that the following *attached* paper or fee

1. New Application Transmittal (12 pages)
2. Added Pages for Application Transmittal where Benefit of Prior US Applications Claimed (5 pages)
3. Specification (46 pages)
4. Claims (2 pages)
5. Drawings (21 pages)
6. Abstract (1 page)
7. Sequence Listing (9 pages)

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10, on the date indicated above and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Nicholas A. Zachariades

12/20/2020
Signature of person mailing paper or fee